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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kinya Matsushita

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EXAMINER

AZIZ, KEITH T

ART UNIT

PAPER NUMBER

1791

NOTIFICATION DATE

DELIVERY MODE

01/06/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/572,943	Applicant(s) MATSUSHITA ET AL.	
	Examiner KEITH T. AZIZ	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/2006, 4/20/2006, 9/24/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to because The holding portion (labeled with 'K') and the base (labeled with '4') appear to be on opposite sides in Figure 3, but appear to be on the same side in Figures 6-7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure is objected to because of the following informalities: There are some grammatical errors throughout the specification. Some of these grammatical errors include the following:

On page 23 of the specification in the immediate application, the specification reads 'Furthermore, as shown in Fig. 5 and Fig 5' - it is unclear as to what the applicant meant to indicate (whether the pertinent feature is only seen in Fig. 5, or whether it is also seen in an additional Figure).

On page 34 of the specification in the immediate application, the specification reads 'Other specific configuration' – it is believed that this portion should read 'Other specific configurations'.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. An operator is not a part of the apparatus of claim 1, and the term 'in which an operator holds by hand in use' should be deleted from the claim, because the operator is not a part of the claimed apparatus.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7-11, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,550,518 (Lee hereafter).

Lee discloses a film-tape eraser with a retractable dispensing head (see title and abstract). Lee teaches a tool with a case body with a first and second case that engage with one another (see items 122 and 126 of Figure 2), a base (see item 6 of Figure 1) that the first and second case may be held in, a pivoting support portion through which the case body parts may pivot to the base (see items 611 and 61 of Figure 2), and a holding portion for holding the transfer tool (see item 5 of Figure 2).

With regards to claim 2, Lee teaches a holding structure that allows the case portions to engage one another, and affixes the case portions to the pivot (see item 5 of Figure 2).

With regards to claim 3, Lee teaches that the base is externally fitted (see item 6 of Figure 1).

With regards to claim 4, Lee teaches that there is a latch (see item 53 of Figure 2) that controls the extent to which the case body and base are engaged.

With regards to claim 5, Lee teaches that there is a pivoted bar (see item 121 of Figure 2) meant to engage the case body portions, and that it may be disengaged by the latch (see item 53 of Figure 2).

With regards to claims 7 and 8, Lee teaches that the pivoting direction is in a plane that is orthogonal to the direction in which the case bodies engage each other (see Figure 2).

With regards to claims 9 and 10, Lee teaches that the tool may pivot through a motion that is generated by a spindle (see item 113 of Figure 2), and a hole in which the spindle is engaged with (see items 61 and 611 of Figure 2).

With regards to claim 11, Lee teaches a transfer head (see items 4 and 223 of Figure 7). This transfer head brings the film into contact with the desired object, and transfers the film to the object when pressure is applied, and is formed in the opening of the base (see Figure 7).

With regards to claim 21, the holding portion implicitly may be a handheld region of the transfer tool.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 12-14, as well as 17-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Lee as applied to claims above, and further in view of U.S. Patent 4,851,076 (Manusch hereafter).

Lee teaches the transfer tool of claims 1-5, 7-11, and 21 as discussed above.

Lee does not explicitly teach a transferred object receiver.

Manusch discloses an adhesive film applicator for applying a film to a surface (see title and abstract). Manusch teaches a transferred object receiver that receives the used transfer film object (see items 13, 15, 17, and 28 of Figure 2, as well as Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transferred object receiver of Manusch in the apparatus of Lee. The rationale to do so would have been the motivation to ensure that an unobjectionable tear edge is generated when the transfer is completed (see lines 1-5 of column 4).

With regards to claim 13, Manusch teaches that the object receiver is pivotable with the base (see item 19 of Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transferred object

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receiver of Manusch in the apparatus of Lee. The rationale to do so would have been the motivation to ensure that an unobjectionable tear edge is generated when the transfer is completed (see lines 1-5 of column 4).

With regards to claim 14, Lee further teaches that there is a guide portion for the transfer tape (see item 223 of Figure 2). Lee does not explicitly teach a transferred object receiver.

Manusch discloses an adhesive film applicator for applying a film to a surface (see title and abstract). Manusch teaches a transferred object receiver that receives the used transfer film object (see items 13, 15, 17, and 28 of Figure 2, as well as Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transferred object receiver of Manusch in the apparatus of Lee. The rationale to do so would have been the motivation to ensure that an unobjectionable tear edge is generated when the transfer is completed (see lines 1-5 of column 4).

With regards to claim 17, Lee further teaches a transfer roller (see items 4, 31, and 32 of Figure 2). Lee does not explicitly teach a transferred object receiver.

Manusch discloses an adhesive film applicator for applying a film to a surface (see title and abstract). Manusch teaches a transferred object receiver that receives the used transfer film object (see items 13, 15, 17, and 28 of Figure 2, as well as Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transferred object receiver of Manusch in the apparatus of Lee. The rationale to do so would have been the motivation to ensure that an

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unobjectionable tear edge is generated when the transfer is completed (see lines 1-5 of column 4).

With regards to claim 18, Lee further teaches that the tool includes a winding off and rolling up spool for applying and recovering the tape body (again, see items 4, 31, and 32 of Figure 2). Lee does not explicitly teach a transferred object receiver.

Manusch discloses an adhesive film applicator for applying a film to a surface (see title and abstract). Manusch teaches a transferred object receiver that receives the used transfer film object (see items 13, 15, 17, and 28 of Figure 2, as well as Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the transferred object receiver of Manusch in the apparatus of Lee. The rationale to do so would have been the motivation to ensure that an unobjectionable tear edge is generated when the transfer is completed (see lines 1-5 of column 4).

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and as applied to claims 1-5, 7-11, and 21 above, and further in view of Applicant Admitted Prior Art Japanese Patent Publication 2002-178694 (Suzuki hereafter).

Lee teaches the process of claims 1-5, 7-11, and 21 as discussed above. Lee does not explicitly teach that there are latching holes.

Suzuki discloses a device for transferring a coating film (see title and abstract). Suzuki teaches that each latching pawl (see item 17 of Figure 2) has a corresponding latching hold formed on the other case (see items 8 and 18 of Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to

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include the latching holes for each latching pawl of Lee as taught by Suzuki. The rationale to do so would have been the motivation to enable the apparatus to exchange transfer tape easily and efficiently (see paragraph [0008]).

11. Claims 15-16, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee and Manusch as applied to claims 12-14, and 17-18 above, and further in view of Suzuki.

Lee and Manusch teach the apparatus of the above claims as previously discussed. Lee and Manusch do not explicitly teach that the guide portion may rotate or detach.

With regards to claims 15-16, Suzuki teaches that the guide portion may rotate with respect to the body (see the rotation of the placement head between Figure 8 and Figure 6). Further, Suzuki teaches that the transfer head may be separate from the case body when the two case body portions are no longer engaged (see Figure 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the rotating guide portion as taught by Suzuki in the apparatus of Lee and Manusch. The rationale to do so would have been the motivation to enable the apparatus to exchange transfer tape easily and efficiently (see paragraph [0008]).

With regards to claims 19-20, Suzuki teaches that unchangable parts are the gears that disperse the transfer film, and then wind up the spent film roll (see item 37 of Figure 7). Again, the spool may be detached and exchanged as is seen in Figure 7 of Suzuki, and the gears are clearly engaged directly (again, see Figure 7). . It would have been obvious to one of ordinary skill in the art at the time the invention was made

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to include the winding gears as taught by Suzuki in the apparatus of Lee and Manusch.

The rationale to do so would have been the motivation to enable the apparatus to exchange transfer tape easily and efficiently (see paragraph [0008]).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are made of record to show the state of the art with respect to transfer film appartuses.

U.S. Patent 5,597,000 to Gerber, drawn to an engaging device with two engaging members.

U.S. Patent 5,445,703 to Steeves et al., drawn to a transfer instrument.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEITH T. AZIZ whose telephone number is (571)270-7658. The examiner can normally be reached on Monday through Thursday 8:00am-6:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna I. Wyrozebski can be reached on (571)272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KTA/

/KHANH NGUYEN/
Primary Examiner, Art Unit 1791